

Pursuant to the Board's Standard Operating Procedure No. 94-02, this opinion has been designated as binding precedent. This appeal was decided March 29, 1996.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SCOTT J. DANIELS

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Appeal No. 95-1612  
Application 29/020,787<sup>1</sup>

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ON BRIEF

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Before: HARKCOM, Vice Chief Administrative Patent Judge,  
and CALVERT, Administrative Patent Judge, and McKELVEY,  
Senior Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

A. Introduction

This appeal is from a decision of a Primary Examiner rejecting the claim in an application for a design patent.

B. The record

Upon review of the file wrappers of the two design patent applications involved in this appeal, it became apparent that numerous papers were out of order and some papers do not appear

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<sup>1</sup> Application for design patent filed April 1, 1994. According to applicant, the application is a continuation of application 07/902,055, filed June 22, 1992, now abandoned.

to have received paper numbers. A "Record on Appeal" has been created which consists of copies of the papers in the file wrapper placed in the order in which the papers were received or entered. In addition, the pages of the "Record on Appeal" have been renumbered in sequential order. The sequential page numbers appear as a hand-written number at the bottom of each page, with the first page being page 0001. A docket entry sheet, which appears at the end of our opinion, contains an index of the "Record on Appeal" and has been prepared to assist applicant and any reviewing court in the event there should be judicial review of our decision. In the event of an appeal to the Federal Circuit, we recommend that a copy of the "Record on Appeal" be used as the Appendix inasmuch as the opinion in support of our decision refers to the renumbered pages of the "new" record.

C. Findings of fact

**"Parent" design application**

1. A "parent" design application, naming Scott J. Daniels ("applicant"), was filed in the Patent and Trademark Office (PTO) on June 22, 1992. Design application 07/902,055 (0002).

2. In a declaration accompanying the "parent" design application, applicant appointed Leon Gilden and E. Michael Combs as attorneys to prosecute the "parent" design application, and directed that correspondence be sent to Gilden (0004).

3. The specification of the "parent" design application states (0002):

BE IT KNOWN THAT I, **SCOTT J. DANIELS**, a citizen of the United States and resident of the State of **Minnesota** have invented a new, original and ornamental design for a

**LEECHER**

of which the following is a specification, reference being had to the accompanying drawings forming a part thereof.

**DESCRIPTION**

Figure 1 is a front elevational view of the **LEECHER** showing my new design;

Figure 2 is a rear elevational view thereof;

Figure 3 is a left side elevational view thereof;

Figure 4 is a right side elevational view thereof;

Figure 5 is a top plan view thereof;

Figure 6 is a bottom plan view thereof; and

Figure 7 is an exploded orthographic [sic--orthographic] view thereof.

I CLAIM:

The ornamental design for a **LEECHER** as shown and described.

4. Figure 1 (0007.1), a front elevational view (0002), as presented with the "parent" design application, was as follows:

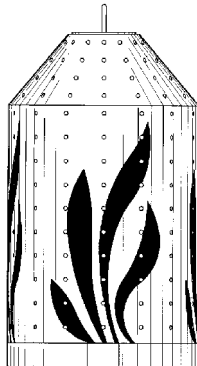
*FIG. 1*



5. Figure 2 (0007.1), a rear elevational view (0002), is essentially identical to Figure 1.

6. Figure 3 (0007.2), a left side elevational view (0002), as presented with the "parent" design application, was as follows:

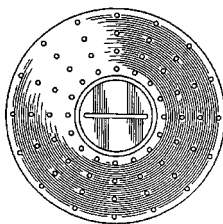
*FIG. 3*



7. Figure 4 (0007.2), a right side elevational view (0002), is essentially identical to Figure 3.

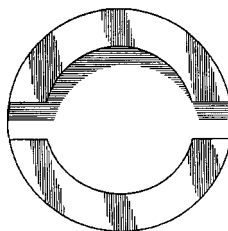
8. Figure 5 (0007.3), a top plan view (0002), as presented with the "parent" design application, was as follows:

*FIG. 5*

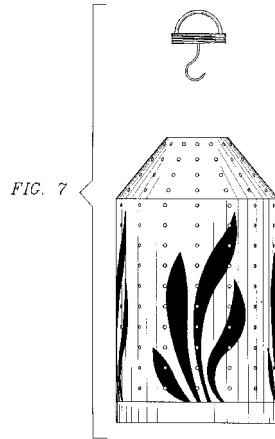


9. Figure 6 (0007.3), a bottom plan view (0002), as presented with the "parent" design application, was as follows:

*FIG. 6*



10. Figure 7 (0007.4), an "exploded orthographic [sic-- orthographic] view" (0002), as presented with the "parent" design application, was as follows:



11. According to applicant, a leecher is "a submersible container used to entrap leeches underwater" (0136).

**Prosecution history of "parent" design application**

12. There came a time when the PTO received documents in the form of affidavits of John Oller (dated 5/12/93) (0017), Jo Ellen Oller (dated 5/19/93) (0020), and Bob Lougher (dated May 20, 1992) (0023).

13. According to the Primary Examiner, John Oller "is apparently a convicted felon under indictment for grand theft of computer equipment from Don Ferrell" (0011; see also 0289).

14. In his affidavit, John Oller states that he was employed by Leon Gilden and Don [E.] Ferrell in "their patent procurement business from 1991 to January 1993" (0017, ¶ 1). John Oller says he was a "chief patent searcher" (id.).

15. In her affidavit, Jo Ellen Oller states that she was employed by Don [E.] Ferrell, as "office manager," from March 1991 to July 1991 (0020, ¶ 1). According to the Primary Examiner, Jo Ellen Oller is now the "ex-wife" of John Oller (0011).

16. John Oller describes what he refers to as "[a]n operating procedure established by Leon Gilden and Don E. Ferrell for their business . . . ." (0017, ¶ 2).

a. American Inventors Corporation forwards a disclosure from an inventor to Gilden. The disclosure supposedly indicates that the inventor wants a utility patent for the useful features of the disclosed invention rather than a design patent (0017, ¶ 2(a)).

b. A draftsman adds decorative ornamentation, apparently of the draftsman's choosing, to the drawings of the invention (0017, ¶ 2(b)).

c. The added ornamentation is said not to have been invented by the inventor (0017, ¶ 2(c)).

d. A design application with drawings having ornamentation is filed in the PTO by Gilden naming the inventor (0017, ¶ 2(d)). We construe John Oller's statement as meaning that the sole inventor named in the design patent application is the inventor client of American Inventors Corporation. Unnamed as an inventor is the individual who designed the surface

ornamentation and placed the surface ornamentation on the article otherwise invented by the inventor client.

e. According to John Oller, Gilden did not explain to inventors the difference between a design patent and a "utility"<sup>2</sup> patent (0018, ¶ 2(f)).

f. Gilden billed American Inventors Corporation for the design patent and American Inventors Corporation then paid Gilden for the services rendered in preparing and filing the design application (0018, ¶ 2(g)).

g. John Oller offers an explanation for the presence of the ornamentation. According to John Oller, Gilden knows that American Inventors Corporation offers all inventors a "money-back guarantee" if a patent does not issue (0018, ¶ 2(h)). Further according to John Oller, Gilden knew that it was much easier to obtain a design patent with the ornamentation added by the draftsman than a "utility" patent "covering the invention intended by the inventor" (id.).

17. In his affidavit, Lougher states that he was employed by American Inventors Corporation from February 1990 until April 1992 (0023, ¶ 1). According to Lougher, part of his duties at American Inventors Corporation included speaking to inventors (0023, ¶ 2). Lougher says that it was the policy of

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<sup>2</sup> We use the word "utility" to refer to patents for inventions patentable under 35 U.S.C. § 101, as opposed to patents for designs patentable as a new, original and ornamental design under 35 U.S.C. § 171.



American Inventors Corporation to "conceal" from inventors the difference between a "utility" patent and a design patent (0023, ¶ 3). Lougher further says that very few of the inventor/clients of American Inventors Corporation understand the difference between a "utility" patent and a design patent (0023, ¶ 7). Further according to Lougher, Gilden is said to have regularly invented ornamental indicia (such as stars or other figures) and added the indicia to drawings of inventions supposedly "for the purpose of obtaining design patents . . ." (0023, ¶ 5). The Gilden practice as described by Lougher is said to be based on policies of American Inventors Corporation which "gives its clients a money-back guarantee and would be liable for a 100% refund if no patent issued" (0023, ¶ 6).

18. After considering the Oller and Lougher affidavits, on October 7, 1993, the Primary Examiner entered an order styled "REQUIREMENT FOR INFORMATION" (0008-0016). The questions were as follows (0014-0015):

Question (1): Did the papers you . . . sent to be used in drafting the instant patent application contain the leaf surface ornamentation of figures 1, 2, 3, 4 & 7?

Question (2): When you signed the declaration attesting to your inventorship, did you review the application papers including the specification and the figures? If yes, was the leaf surface ornamentation present on the figures?

Question (3): Did you invent the leaf surface ornamentation?

Question (4): Did you invent the use of the leaf surface ornamentation on the surface to which it is applied?

Question (5): Did you instruct anyone generally to add surface ornamentation to the figures?

Question (6): At the time you signed the declaration attesting to your inventorship, did you intend to apply for a design patent (covering the ornamental appearance) rather than a utility patent (covering the function)?

Question (7): At the time you signed the declaration attesting to your inventorship, were you aware of the difference between a design and a utility patent?

19. On October 7, 1993, the same day the REQUIREMENT FOR INFORMATION was entered, the PTO received in its Mail Room an ASSOCIATE POWER OF ATTORNEY dated 9/10/93 (0026). The power of attorney reached Patent Examining Group 2900 (the PTO group where design applications are examined) on October 8, 1993 (id.). The letter was signed by Combs and appointed S. Michael Bender as an "associate attorney" and directed that all future correspondence be sent to Bender (id.). There is no evidence in the record that the applicant was previously or simultaneously notified of the appointment of Bender as an "associate attorney." Likewise, the

record contains no document signed by the applicant appointing Bender as an attorney.

**Prosecution history of the "continuing"  
design application on appeal**

20. On April 1, 1994, applicant, through Bender, filed a "continuing" design application under 37 CFR § 1.62 (0030). Accompanying the "continuing" design application were:

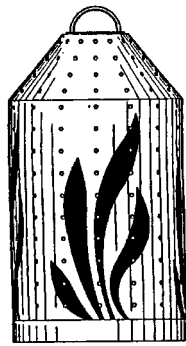
a. A petition and fee for extension of time under 37 CFR § 1.136(a) (0028)--which was necessary to make the filing of the "continuing" design application timely in response to the REQUIREMENT FOR INFORMATION in the "parent" design application.

b. A first set of answers to the REQUIREMENT FOR INFORMATION signed by the applicant on 11/20/93 (0036).

c. A preliminary amendment (0033), including a LETTER TO OFFICIAL DRAFTSMAN (0038).

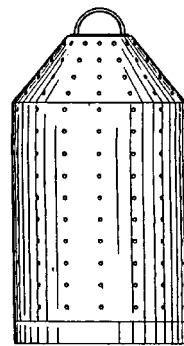
21. The "preliminary amendment" requested that Figures 1, 2, 3, 4 and 7 be amended to delete the "surface pattern" (0033, 0039-0040, and 0042):

FIG. 1



Prior to  
amendment

FIG. 1

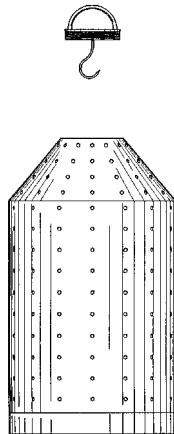


After  
amendment

22. The sole claim in applicant's "continuing" design application reads (0002):

The ornamental design for a **LEECHER**  
as shown and described.

23. The leecher presently shown and described in applicant's "continuing" design application is one without surface ornamentation, as shown by representative Figure 7:



24. Before any action by the Primary Examiner in the "continuing" design application, on May 4, 1994, applicant filed:

a. A PETITION TO MAKE SPECIAL UNDER 37 CFR § 1.102(a) (0044).

b. A second PRELIMINARY AMENDMENT (0047), containing, inter alia, the following statement: "The undersigned counsel [Bender] for applicant has forwarded the questions contained in the Requirement [for Information] to the applicant for his review and response. Attached to and made part of this Amendment is the response of applicant Scott J. Daniels to the questions contained in the Requirement over his original signature" (0049, second paragraph, last two sentences).

c. A second set of answers to the REQUIREMENT FOR INFORMATION signed by the applicant on 4/5/94 (April 5, 1994) (0055-0063).

25. According to the PETITION TO MAKE SPECIAL, the "continuing" design application "represents a prototypical fact pattern which involves at least one of the following controlling questions of law which are common to the prosecution of a majority of some 1700 patent applications" (0044).

a. The first "controlling question" was said to be whether removal of the "surface ornamentation" from the figures of the drawings in a design application constitutes "new matter" (0044-0045).

b. A second "controlling question" was said to be whether a "continuing" design application claiming an article without surface ornamentation is entitled to the benefit of the filing date of an earlier design application claiming an article with surface ornamentation (0045).

26. The second "controlling question" was said to be important, because "applicant's own publication may constitute a statutory bar if the continuing application is not entitled to the filing date of the parent [design] application" (0045).

27. The Director of Patent Examining Group 2900 granted the petition to make special (0064).

28. Insofar as we can tell, the PRELIMINARY AMENDMENT filed May 4, 1994, sought to make essentially the same changes as the PRELIMINARY AMENDMENT which accompanied the papers filed on April 1, 1994 (compare 0039-0042 with 0051-0054).

29. On June 28, 1994, the Primary Examiner entered an office action (0065-0070). The Primary Examiner noted discrepancies between the first set of answers and the second set of answers to the REQUIREMENT FOR INFORMATION (0066). The Primary Examiner required an explanation (id.). The Primary Examiner also determined that applicant was not entitled, under 35 U.S.C. § 120, to the benefit of the filing date of the "parent" design application (0067). The Primary Examiner acknowledged applicant's statement that "his own 'publication'"

may be a statutory bar, but noted the absence of any Information Disclosure Document (37 CFR § 1.56) (0069-0070).

30. A review of the first and second set of answers to the REQUIREMENT FOR INFORMATION shows that applicant's answers are not entirely consistent. We note that the first and second set of answers do not appear on copies of the same paper (compare 0036-0037 with 0061-0062). The first set of answers seemingly was made on a paper which appears to have been a "retyped" version of the questions essentially as they appeared in the REQUIREMENT FOR INFORMATION entered by the Primary Examiner. The second set of answers appears on what seems to be a photostatic copy of the REQUIREMENT FOR INFORMATION entered by the Primary Examiner. The answers were as follows:

Question (1): Did the papers you . . . sent to be used in drafting the instant patent application contain the leaf surface ornamentation of figures 1, 2, 3, 4 & 7?

Answer of 11/20/93: **No they did not** (0036).

Answer of 4/5/94: **No** (0061).

Question (2): When you signed the declaration attesting to your inventorship, did you review the application papers including the specification and the figures? If yes, was the leaf surface ornamentation present on the figures?

Answer of 11/20/93: **Yes, Yes** (0036).

Answer of 4/5/94:      **No** (0061).

Question (3): Did you invent the leaf surface ornamentation?

Answer of 11/20/93:    **No, American Inventors added the leaf's to my invention** (0036).

Answer of 4/5/94:      **No** (0061).

Question (4): Did you invent the use of the leaf surface ornamentation on the surface to which it is applied?

Answer of 11/20/93:    **No, I don't know who did** (0036).

Answer of 4/5/94:      **No** (0061).

Question (5): Did you instruct anyone generally to add surface ornamentation to the figures?

Answer of 11/20/93:    **Yes, I told American Inventors to add a design if they felt it would help in the sale of such an invention** (0037).

Answer of 4/5/94:      **No** (0061).

Question (6): At the time you signed the declaration attesting to your inventorship, did you intend to apply for a design patent (covering ornamental appearance) rather than a utility patent (covering the function)?



Answer of 11/20/93: **No, I fully intended to apply for a Utility Patent covering the function** (0037).

Answer of 4/5/94: **Yes** (0061-0062).

Question (7): At the time you signed the declaration attesting to your inventorship, were you aware of the difference between a design and a utility patent?

Answer of 11/20/93: **No, I was not aware of the difference. I thought the Design Patent Application covered + drawing of the trap as well as it's (sic--its) use or function** (0037).

Answer of 4/5/94: **Yes** (0062).

31. In response to the request by the Primary Examiner for an explanation of the "discrepancies" in the two sets of answers, applicant filed a DECLARATION OF SCOTT J. DANIELS (0096). According to the DECLARATION (0096, ¶ 4):

I am a layman with no experience in the patent law. I answered the Requirement For Information in my first response dated November 20, 1993 without the benefit of advice of counsel and did not completely understand the questions at that time.

32. Further according to the DECLARATION (0096, ¶ 5):

I answered the Requirement For Information in my second response dated April 5, 1994 after having received advice of

counsel so that I was able to more fully understand the questions and give accurate answers.

33. Lastly, the DECLARATION notes (0096, ¶ 6):

My answers in my second response dated April 5, 1994 to the Requirement For Information, which answers I have verified, are accurate.

34. At the same time the second set of answers to the REQUIREMENT FOR INFORMATION were presented, applicant also filed an INFORMATION DISCLOSURE STATEMENT (0097). One item mentioned in the INFORMATION DISCLOSURE STATEMENT was the following (0098, under OTHER DOCUMENTS): "Brochure distributed by American Inventors Corporation approximately during" (typewritten) and "August 1992" (handwritten).

35. According to applicant's BRIEF ON APPEAL (0137):  
[the] "marketing brochure" [(0120) was] distributed  
after the filing date of the prior ["parent" design]  
application, but more than one year prior to the filing  
date of the present ["continuing" design] application.

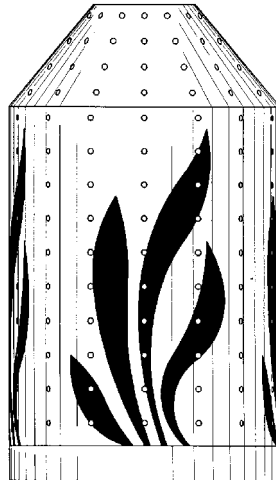
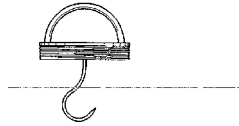
36. The brochure contains the following information  
(0120).

# Leecher

Scott J. Daniels  
#S-618

## PRODUCT FEATURES

1. This special trap is designed to catch leeches which then can be used for bait.
2. The trap is baited with liver or a similar attractive material.
3. Left overnight, the fisherman can expect to find numerous leeches in the trap the next morning.
4. Constructed of durable corrosion resistant materials.
5. Weighted to assure it rests firmly on the bottom.
6. Effective, practical, and convenient.



37. Upon consideration of the Brochure and other prior art, on September 13, 1994, the Primary Examiner entered an office action and rejected the sole claim in the "continuing" design application as being unpatentable under 35 U.S.C. § 103, relying on the Brochure in view of a patent to Nelson<sup>3</sup> (0126). The Primary Examiner also rejected the sole claim for failure to comply with the "description" requirement of 35 U.S.C. § 112, first paragraph (0126, second paragraph).

38. A notice of appeal was timely (0132).

39. Applicant also timely filed a BRIEF ON APPEAL (0133-0169). The brief contains an argument that benefit should not be denied based on who is named (or not named) as an inventor (0156-0158). Since the Examiner's Answer does not base refusal to accord benefit under 35 U.S.C. § 120 on "inventorship," we have no occasion to discuss the "inventorship" arguments made in the BRIEF ON APPEAL.

40. With respect to the rejection of the sole claim under 35 U.S.C. § 103 as unpatentable over the prior art, applicant argued that the rejection was erroneous because applicant is entitled under 35 U.S.C. § 120 to the benefit of the filing date of the "parent" design application (0138). While applicant acknowledged that a § 103 rejection was made (0137), no argument was presented in the brief that the subject matter of

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<sup>3</sup> U.S. Design Patent N° 128,787, granted August 12, 1941 (0129).

the sole claim is non-obvious on the merits over the combined teachings in the Brochure and the Nelson patent apart from an argument that the Brochure is "antedated" under 35 U.S.C. § 120. Hence, there is no need to make findings with respect to (1) what is described in the Nelson design patent, (2) the differences between the prior art and the subject matter claimed, and (3) the level of skill of a designer of ordinary capability who designs articles of the type presented in the "continuing" design application. 37 CFR § 1.192(c)(6). The sole issue with respect to the rejection under 35 U.S.C. § 103 is whether the Brochure is prior art and that sole issue turns on whether applicant is entitled, under 35 U.S.C. § 120, to the benefit of the filing date of the "parent" design application.

41. An Examiner's Answer was mailed on January 11, 1995 (0173).

42. In a COMMUNICATION sent to the PTO by facsimile received January 17, 1995, applicant waived the filing of a reply brief (0188). Oral argument before a panel of the board had previously been waived (0133).

#### **The petition**

43. By a document dated April 18, 1994, styled PETITION FOR PERSONAL INTERVENTION BY THE COMMISSIONER OF PATENTS, THE HONORABLE BRUCE A. LEHMAN ("Petition"), and signed

by Bender, certain relief was sought in connection with 1,700 patent applications.<sup>4</sup>

44. Exhibits 1 through 6 accompanied the petition. Relevant to the potential issue(s) raised in this "continuing" application are:

- a. Exhibit 3 (0285) which is a copy of a form letter which Bender "has undertaken to write each of the inventors . . ." (0278).
- b. Exhibit 5 (0295) is a listing of then pending applications where a requirement for information has been entered (0282, n.9). Among those listed is applicant's "parent" design application (0297).

45. The Petition indicated that there was a "problem" with 1,700 patent applications (0265). According to the Petition (id.):

The problem derives from the fact that the applications of the 1700 inventors (and quite probably the applications of hundred more) have been tainted, because persons other than the inventors, without authorization, added ornamentation to the designs presented for patenting.

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<sup>4</sup> Parts of the Petition are made of record in this "continuing" application (0265-0298). We have deleted from the attachments to the Petition all references to applications of inventors other than applicant Daniels, except for those applications which one of applicant's counsel has revealed on the record of this "continuing" application. See, e.g. (0171).

46. According to the Petition (0268):

At its core, the problem has to do with procedures by which (apparently) a patent service company ("Patent Place") and/or Mr. Leon Gilden, a registered patent attorney currently under suspension,<sup>[5]</sup> while preparing patent applications and drawings depicting the inventions, added various kinds of surface ornamentation to the underlying conceptions of the inventors. It is not clear why these persons added the ornamentation, whether to improve the chances of obtaining patents, to promote the marketing of the inventions, or for some other purpose. But whatever their reasons, this addition of ornamentation has raised (and continues to raise) serious questions about the "inventorship" of the designs which the applicants submitted for patenting . . . .

47. The Petition acknowledges that "in the instant circumstances, the Patent Office apparently perceived (correctly it appears) that there existed a program of wholesale ornamentation distorting hundreds of inventions" (0270).

48. The Petition reveals that (0275):

Each of the inventors is a contract party with American Inventors Corporation, an invention marketing company.

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<sup>5</sup> Notice of Gilden's suspension was published in the Official Gazette. See 1160 Off. Gaz. Pat. Office 39 (Mar. 8, 1994) (0264).

In their contracts, the inventors delegated to American Inventors [Corporation] the right to select patent counsel.

49. In the "form letter" (0285), Bender indicates, among other things, that American Inventors Corporation asked Bender to accept responsibility for representing the inventor in connection with all further proceedings at the PTO regarding your "original" application for patent.

50. The "form letter" contains a brief description of the difference between a "utility" and a "design" patent (0286). A utility patent was said to cover the function of a product--how it works (id.). A design patent was said to cover the appearance of a product--how it looks (id.).

51. With respect to design patents, the "form letter" states (0286):

The subject matter of a "design" patent may be  
i) the shape of a product, as for example a novel shape for a tea kettle; (ii) ornamentation placed on the surface of a product, such as a depictions [sic--depiction] of flowers on the surface of a tea kettle; or (iii) a combination of both the shape of a product and ornamentation on the surface of the product.

52. The "form letter" advises the inventor that a design must be "ornamental" and cannot be "functional" (0286).



53. Continuing, the "form letter" states (0286):

Although design patents and utility patents are different in the form of protection they provide, they may both prove to be valuable to the inventor if the subject of the patent attracts buyers in the marketplace. \* \* \*. You should have clearly in mind what kind of patent we are seeking to obtain for you as we go forward with the patent application process.

54. The "form letter" acknowledges that John Oller, his wife (i.e., Jo Ellen Oller), and Bob Lougher submitted information to the PTO (0288-0289). John Oller is characterized as having been "fired . . . for theft" (0288, last line) and as a "convicted criminal" (0289, third full paragraph). Bob Lougher is characterized as "a disgruntled<sup>[6]</sup> former American Inventors [Corporation] employee currently in a legal dispute with American Inventors [Corporation]" (0289, second full paragraph).

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<sup>6</sup> The characterization of Bob Lougher, also known as Robert Lougher, as "disgruntled" is correct to the extent Lougher has told a Senate Subcommittee that he walked away from American Inventors Corporation when he found that practices at the corporation were unacceptable to him. See e.g., Caveat Inventor: Invention Marketing Scams: Hearing Before the Senate Subcommittee on Regulation and Government Information of the Committee on Governmental Affairs, 103d Cong., 2d Sess. 15-17 and 44-48 (1994) (0317-0319 [oral testimony]; 0320-0324 [prepared statement]). We note that the Federal Trade Commission has announced that it has charged American Inventors with running a deceptive invention-promotion scheme that bilked consumers nationwide out of thousands of dollars each over a 20-year time span. FTC News, Press Release of October 26, 1995 (0325). We also note that the FTC has obtained injunctive relief from a U.S. District Court. See Federal Trade Commission v. American Inventors Corp., 37 USPQ2d 1154 (D. Mass. 1995) (0328).

55. According to the "form letter," John Oller is said to have told PTO (0289, first full paragraph):

that Mr. Gilden and draftsmen at the search and drafting firm invented or co-invented patterns of surface decoration applied to the design as to which you have applied for a patent.

The "form letter" advises (0289, fourth full paragraph):

I must tell you that what I have learned to date in a limited number of cases does not disprove the allegations concerning the addition of surface ornamentation, and creates concerns in my mind about a number of applications filed by Mr. Gilden, including yours.

56. The "form letter" tells the inventor that American Inventors Corporation sent out marketing brochures and, where "continuing" applications have been filed, there may be a problem, although it notes arguments can be made to overcome the problem (0290, third and fourth full paragraphs).

57. In the "form letter," Bender states that (0290, last paragraph):

I had no involvement with either of your applications until American Inventors [Corporation] retained me in mid-1993 to help straighten out this unfortunate and complicated situation.

### **Applicant's submission of new evidence after appeal**

58. Upon indication by applicant that a reply brief would not be filed, jurisdiction over the appeal transferred to the Board of Patent Appeals and Interferences. Manual of Patent Examining Procedure, § 1210 (6th ed., rev. 1, Sept. 1995).

59. On March 31, 1994, the Board received a document styled SUBMISSION OF NEW EVIDENCE UNDER 37 CFR 1.194 (sic--1.195)(0189). Attached to the SUBMISSION were several "pairs" of design patents. According to applicant, the "pairs" represent situations in which "division" design patents claim a portion of a design described and claimed in an "original" design patent. "That is, portions of the design illustrated in the drawings of each original application are deleted from the drawings in the corresponding division" (0190).

60. The SUBMISSION suggested that the patents could be judicially noticed (0200, second full paragraph).

61. The following was presented in the SUBMISSION to explain why the patents were not earlier presented (0200, last paragraph):

The appended patents were not sooner presented to the [Primary] Examiner because counsel was unaware of their existence prior to March 2, 1995. It was on that date that patents . . . appended hereto were brought to the attention of the undersigned [S. Michael Bender] by co-counsel [unidentified] during continuing research into the issues

presented by this appeal. The remaining patents appended hereto were uncovered subsequently by a further diligent search. Applicant's counsel is continuing his search investigation to uncover additional similarly related design patents.

### **Adjudicative findings**

62. The leecher design in the "parent" design application is a different design from the leecher design in the "continuing" design application, as amended.

63. The leecher design in the "parent" design application and the "continuing" design application, as filed, is a leecher containing thereon surface ornamentation.

64. The leecher design in the "continuing" design application, as presently claimed, is a leecher without surface ornamentation.

65. The design of the article of manufacture presently claimed in the "continuing" design application is not described in the "parent" design application.

66. The design of the article of manufacture presently claimed in the "continuing" design application was not described in the "continuing" design application as filed.

### **D. Discussion**

There are four issues raised by the record:

**Issue No 1:** Whether the sole claim in the "continuing" design application is unpatentable under 35 U.S.C. § 103, which turns solely on whether the sole claim in the "continuing" design application is entitled, under 35 U.S.C. § 120, to the benefit of the filing date of the "parent" design application. The Primary Examiner determined that applicant was not entitled to the benefit of the "parent" design application. Applicant has not challenged the merits of the obviousness holding by the Primary Examiner. Hence, there is no occasion to discuss the merits of the Primary Examiner's obviousness holding. Compare In re Salmon, 705 F.2d 1579, 1580, 217 USPQ 981, 983 (Fed. Cir. 1983).

**Issue No. 2:** Whether the sole claim in the "continuing" design application is unpatentable for failure to comply with the description requirement of 35 U.S.C. § 112, first paragraph, in the "continuing" design application, as filed. The Primary Examiner determined that applicant did not comply with the description requirement in the "continuing" design application, as filed.

**Issue No. 3:** Whether applicant is claiming what he regards as his invention within the meaning of 35 U.S.C. § 112, second paragraph. There is no indication on the record that the Primary Examiner has considered this issue.

**Issue No. 4:** Whether the design, as claimed, complies with the requirements of 35 U.S.C. § 171 with respect to ornamentality, i.e., whether the design as claimed is dictated

primarily by functional considerations. There is no indication on the record that the Primary Examiner has considered this issue.

Issues No. 1 and 2 stand or fall together. If the "parent" design application describes the claimed design, then applicant is entitled to the benefit of the filing date of the "parent" design application and the Brochure is not prior art. There would then be no basis for rejecting the sole claim of the "continuing" design application under 35 U.S.C. § 103. Likewise, if the "continuing" design application, at the time it was filed, describes the claimed design, then applicant will have complied with the description requirement of 35 U.S.C. § 112, first paragraph. Whether the "parent" design application describing a leecher with surface ornamentation and whether a "continuing" design application describing a leecher with surface ornamentation, as filed, also describe the same leecher without surface ornamentation is dispositive of both issues.

1. Resolution of Issues No. 1 and 2

a. The question of whether subject matter is described in a specification is a question of fact. In re Alton, \_\_ F.3d \_\_\_, \_\_\_, 37 USPQ2d 1578, 1580 (Fed. Cir. 1996); Utter v. Hiraga, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988) (and cases cited therein).

The design described in a design patent application is the item shown in the drawings. A design has been described by the former U.S. Court of Customs and Patent Appeals (CCPA) as "a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design."

In re Blum, 374 F.2d 904, 907, 153 USPQ 177, 180 (CCPA 1967).

The former CCPA also had occasion to make the following statement:

an inventor may invent, we will say for the purposes of this case, at least three kinds of designs for articles of manufacture. First a design for an ornament, impression, print or picture to be applied to an article of manufacture; second, the design for a shape or configuration for an article of manufacture; third, a combination of the first two, that is, a design which consists of the shape or configuration of an article plus additional ornamentation.

In re Schnell, 46 F.2d 203, 209, 8 USPQ 19, 25 (1931). The statement in Schnell is entirely consistent with an earlier observation of the Supreme Court:

[a]nd the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or

article to which it may be applied, or to which it gives form.

\* \* \* \* \*

It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing, or product, which the patent law regards.

Gorham Mfg. Co. v. White, 81 U.S. (14 Wall.) 511, 525 (1872).<sup>7</sup>

There is, and can be, no debate that a design patent application may be entitled to the benefit of the filing date of an earlier design application when the earlier design application describes the design claimed in the manner required by the first paragraph of 35 U.S.C. § 112. See 35 U.S.C. § 120. However, we note that the "best mode" provision of the first paragraph of § 112:

is not applicable, as a design has only one "mode" and it can be described only by illustrations showing what it looks like (though some added

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<sup>7</sup> See also Manual of Patent Examining Procedure, § 1502 (6th ed., rev. 1, Sept. 1995).



description in words may be useful to explain the illustrations).

Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418, 1420, 11 USPQ2d 1300, 1301 (Fed. Cir. 1989) (en banc).

Consistent with Racing Strollers is the Federal Circuit's observation that when a

design is changed, the result is a new and different design; the original design remains just what it was. Design patents have almost no scope.

In re Mann, 861 F.2d 1581, 1582, 8 USPQ2d 2030, 2031 (Fed. Cir. 1988).

b. This appeal seemingly raises an issue of first impression before the Board of Patent Appeals and Interferences in design cases. We have found no binding precedent where an applicant (or design patentee) attempted to claim the benefit, in a later filed design application, of the filing date of an earlier application describing an article of manufacture having a particular configuration with surface ornamentation, where the later filed design application claimed a design of the article of manufacture without surface ornamentation. Nor have we found binding precedent where an applicant filed a design application describing and claiming an article of manufacture having a particular configuration with surface ornamentation, and later

sought to eliminate the surface ornamentation to claim solely the configuration of the article of manufacture.

We became aware of Ashley v. Samuel C. Tatum Co., 186 F. 339 (2d Cir. 1911), during our consideration of the appeal.

According to Chisum, Patents, § 1.04[4] (1990):

[t]he drawings of the [design] patent showed a certain configuration. The claim was to the "ornamental design for an inkstand, as shown." The defendant's inkstand was of the same configuration but added ornamentation around the base. Relying on the narrow, "as shown" form of claim, the Second Circuit found no infringement since an ordinary observer would readily distinguish the two inkstands.

Apart from the fact Ashley is not binding precedent and involves an issue of infringement, a review of the drawing in the Ashley design patent and a drawing of the defendant's inkstand (186 F. at 340) reveals that the "ornamentation" is not surface ornamentation of the type involved in this appeal.

Likewise, this appeal does not raise the same issue resolved by the Federal Circuit in In re Salmon, supra. In Salmon, the Federal Circuit determined, in a reissue context, that a description in an earlier filed design application of a chair with a square seat was not a description of a chair with a circular seat claimed in a subsequently filed design application. The Federal Circuit determined that the subsequently filed design

application was not entitled to the benefit of the filing date of the earlier filed design application.

c. On the record before us, it is our finding that the design of the configuration of the leecher with the surface ornamentation is not the same design as the configuration of the leecher without the surface ornamentation. The surface ornamentation on the leecher described in the "parent" design application contributes to the overall appearance and manifestly gives a different impression from the leecher without the ornamentation. The leecher with surface ornamentation is one "unitary thing." In re Blum, supra. The leecher without surface ornamentation is another and different "unitary thing."

Assuming the leecher design with surface ornamentation was prior art, it would not anticipate a leecher design having the same configuration, but without surface ornamentation. In this respect, we totally agree with the Primary Examiner's decision to base the rejection of the sole claim on appeal under 35 U.S.C. § 103, instead of 35 U.S.C. § 102(b). Nor does the fact that the leecher with surface ornamentation would have rendered the leecher without surface ornamentation obvious, within the meaning of 35 U.S.C. § 103, mean that the "parent" design application and/or the "continuing" design application, as filed, describe a leecher without surface ornamentation. Compare In re Salmon, 705 F.2d at 1582, 217 USPQ at 984 (involving design

applications), citing In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978) (involving "utility" applications).

d. Applicant argues that the Primary Examiner applied an erroneous standard with respect to the "description" requirement of the first paragraph of 35 U.S.C. § 112. We disagree. Applicant correctly argues that to obtain the benefit of the filing date of an earlier application, an applicant need only show that the earlier application contains a written description of the invention claimed in a continuing application (0139). Applicant specifically emphasizes certain language in the first paragraph of 35 U.S.C. § 112: "contain a written description of the invention" (0139--emphasis by applicant). Applicant maintains that an applicant complies with the "written description" requirement of the first paragraph of 35 U.S.C. § 112 if the specification conveys to one skilled in the art with reasonable clarity that the inventor was in possession of the invention at the time an application is filed. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1993) (claims in later filed "utility" application entitled to benefit of filing date of earlier filed "design" application); Utter v. Hiraga, 845 F.2d at 999, 6 USPQ2d at 1714 (later filed "utility" application entitled to benefit of filing date of earlier filed Japanese "utility" application for purpose of

priority); In re Gosteli, 872 F.2d 1008, 10 USPQ 1614 (Fed. Cir. 1989) (claims in later filed "utility" application not entitled to benefit of earlier filed Japanese "utility" application). Finally, applicant maintains that no one looking at the design of the leecher in Figure 1, as originally filed, in applicant's "continuing" design application can reasonably doubt that applicant was in possession of the design of the leecher in Figure 1, as amended, as of the filing date of the "parent" or "continuing" design application (0141).

Applicant's logic and argument overlooks or misapprehends the following points:

(1) the invention sought to be patented by applicant is a design;

(2) the term "invention" in the phrase "contain a written description of the invention" in 35 U.S.C. § 112, first paragraph, refers to the design sought to be patented;

(3) a design is a unitary thing where all of its portions are material in that they contribute to the appearance which constitutes the design; and

(4) the design sought to be patented (leecher without surface ornamentation) is a different design than the design described in the "parent" design application and the "continuing" design application, as filed (leecher with surface ornamentation).

Thus, applicant errs in arguing that "the leecher ***as claimed*** in appellant's later filed ['continuing' design] application is 'identically' disclosed in the prior ['parent' design] application." (0141). The two designs are not identical; binding precedent tells us that they are two different designs.

Applicant also maintains that the "parent" design application describes three designs, but claims only one design (0142). According to applicant, the "parent" design claimed a combination of a configuration and surface ornamentation (0143). Further argues applicant, "the prior ['parent' design] application disclosed the configuration of the leecher which appellant here claims without surface ornamentation" (id.). Applicant points to no drawing in the "parent" design application of a leecher without surface ornamentation, again overlooking the fundamental design criteria that a design is a unitary thing where all of its portions are material in that they contribute to the appearance which constitutes the design. In re Blum, supra. This is not a case where an applicant presented two versions of a leecher in a "parent" design application--one with surface ornamentation and one without surface ornamentation. Thus, we do not have here a case where:

- (1) applicant filed a "first" design application containing a Figure 1 leecher without ornamentation and a Figure 2 leecher with ornamentation;

- (2) the Primary Examiner required restriction between the design of Figure 1 and the design of Figure 2;
- (3) applicant elected to prosecute the Figure 1 design in the "first" design application; and
- (4) applicant further elected to file a "second" design application to prosecute the Figure 2 design.

Under the circumstances just outlined, there is no question that the design claimed in the "second" application would be entitled to the benefit of the filing date of the "first" application, because both unitary designs were described in the "first" application.

Applicant correctly points out that a "parent" case need not claim (or ever have claimed) the subject matter sought to be patented in a "continuing" application (0144). But, we disagree with applicant that Schnell and In re Rubinfeld, 270 F.2d 391, 123 USPQ 210 (CCPA 1959), cert. denied, 362 U.S. 903 (1960), "make clear that a design application illustrating a picture applied to an article (as in the prior ['design' patent] application), appropriately and necessarily discloses the configuration of that article . . ." (0144). The issue in Schnell was breadth of the claim. It does not appear that Schnell presented two designs in his application, as filed. In Rubinfeld, the design specification contained figures "of two floor waxers of generally similar but specifically different

appearance . . . ." 270 F.2d at 392, 123 USPQ at 211. The breadth of applicant's claim in this "continuing" design application is clear; hence, there is no "breadth" problem here as in Rubinfield. Nor did applicant present drawings for two designs of leechers.

Applicant makes the further argument that "[t]he combination of design elements comprising the shape of appellant's article and the ornamentation placed on the surface of the article, may be properly deconstructed to its subset design" (0145). In the abstract, and perhaps for some purpose unrelated to the issues on appeal, it is possible that applicant could be correct--a matter we do not prejudge. However, as applied to the facts of this case, we cannot agree that the leecher described in the "parent" design application may be "deconstructed" to its "subset" designs of leecher and surface ornamentation for the purpose of complying with the description requirement of the first paragraph of 35 U.S.C. § 112. Applicant's argument runs afoul of the proposition so clearly set out in Blum that a design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design. For these same reasons, applicant incorrectly argues that the "parent" design application "inherently" describes the design now being claimed in the "continuing" design application (0146). Applicant has not shown that the facts here involve a situation where a specification or a claim is being amended to correct an



obvious error,<sup>8</sup> to insert an "inherent characteristic" or microstructure of a ceramic otherwise fully described,<sup>9</sup> or to claim a function which is inherently performed by an apparatus disclosed in a drawing thereby permitting an applicant to copy a claim for purposes of an interference.<sup>10</sup>

It is true that the drawings in an earlier design or utility application alone may provide a written description of subject matter claimed in a later filed application. Racing Strollers, 878 F.2d at 1420, 11 USPQ2d at 1301. However, in this case, the drawings in the "parent" application do not provide a written description of the design now claimed in the "continuing" design application. The drawings in the "parent" application were changed in the "continuing" design application to "a new and different design; the original design remains just what it was." In re Mann, 861 F.2d at 1582, 8 USPQ2d at 2031.

e. On this record one cannot help becoming aware of the circumstances under which applicant came to file his design applications. Unfortunately, there are so-called invention promotion organizations which do not necessarily act in the best interests of their inventor clients. However, the PTO is an

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<sup>8</sup> In re Oda, 443 F.2d 1200, 1205, 170 USPQ 268, 271 (CCPA 1971).

<sup>9</sup> In re Nathan, 328 F.2d 1005, 140 USPQ 601 (CCPA 1964); Kennecott Corp. v. Kyocera International, Inc., 835 F.2d 1419, 5 USPQ2d 1194 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988).

<sup>10</sup> In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971).

agency of limited jurisdiction. The tasks assigned by Congress to date to the PTO do not include oversight, registration, or regulation of invention promotion organizations. Congress has assigned to others the task of investigating unlawful practices and taking such action as may be appropriate when those practices are found to exist. Over the years, there has been considerable activity in this respect in the invention promotion field. One need only observe the following cases and publication: In the Matter of the Raymond Lee Organization, Inc., 92 F.T.C. 489 (1978), aff'd sub nom. Lee v. Federal Trade Commission, 679 F.2d 905 (D.C. Cir. 1980) (invention promotion organization committed unfair trade practices under the Clayton Act); United States v. Beecroft, 608 F.2d 753, 757 (9th Cir. 1979) (invention promoter convicted of mail fraud; one who acts with reckless indifference to whether a representation is true or false is chargeable with knowledge of its falsity); In re Raymond Lee Organization, Inc. Securities Litigation, 446 F. Supp. 1266 (J.P.M.L. 1978); People v. Lawrence Peska Associates, Inc., 393 N.Y.S.2d 650 (Sup.Ct. 1977); Marshall v. New Inventor's Club, Inc., 117 N.E.2d 737 (Ohio Ct. Com. Pleas 1953); Shemin Idea Promoter Control: The Time Has Come, 60 J. Pat. Office Soc'y 261 (1978). We note that the Federal Trade Commission has filed a complaint (0325),<sup>11</sup> and

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<sup>11</sup> See FTC News, "FTC charges Massachusetts companies with running nationwide invention-promotion fraud" (Oct. 26, 1995).

has obtained an injunction (0328),<sup>12</sup> against American Inventors Corporation and that at least one individual (Bob Lougher) formerly associated with American Inventors Corporation has testified on the subject of invention promotion organizations before a subcommittee of the Senate during the 103d Congress (0317-0319 [oral testimony]; 0320-0324 [prepared statement]).<sup>13</sup>

In resolving the § 112 and § 120 issues before us, we are limited to considering the words of the statute and the specifications of the "parent" and "continuing" design applications as filed, and the "continuing" design application, as amended. As Judge Rich so aptly noted for a unanimous en banc Federal Circuit, "[t]here are no 'otherwise provided' statutes" which govern resolution of the § 112 and § 120 issues before us. Racing Strollers, 878 F.2d at 1421, 11 USPQ2d at 1302 (second column). Hence, we wish to make clear that insofar as resolution of § 112 and § 120 issues before us is concerned, no weight has been given to the underlying circumstances which led to the filing of the "parent" and "continuing" design applications and/or the amendment of "continuing" design application or to any investigation, congressional or administrative, which may be underway with respect to American Inventors Corporation.

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<sup>12</sup> Federal Trade Commission v. American Inventors Corp., 37 USPQ2d 1154 (D. Mass. 1995).

<sup>13</sup> Caveat Inventor: Invention Marketing Scams: Hearing Before the Senate Subcommittee on Regulation and Government Information of the Committee on Governmental Affairs, 103d Cong., 2d Sess. (1994).

f. Applicant, through counsel, attempted to introduce into the record evidence, in the form of various design and other patents, said to have been discovered after the appeal was filed. See Findings 58-61 on pages 25-27. According to Bender, applicant's counsel, the patents were not sooner presented to the Primary Examiner because counsel was unaware of their existence prior to March 2, 1995, the date on which the patents are said to have been brought to Bender's attention by unidentified co-counsel (0200). Other patents submitted for consideration were said to have been uncovered subsequently by a further diligent search (id.).

The applicable PTO regulations require that an applicant, in this case an applicant's counsel, show that there are "good and sufficient reasons why" the evidence was not earlier presented. 37 CFR § 1.195. Counsel's excuse is not a good and sufficient reason, within the meaning of Rule 195. The § 120 benefit issue was raised long before the time applicant filed the BRIEF ON APPEAL. The design patents presented with the SUBMISSION have also been in existence for some time. Hence, we will not admit or consider on the "merits" the SUBMISSION and the design patents attached to the SUBMISSION.

Even if the SUBMISSION were timely, there are other reasons why the SUBMISSION should not be considered on its merits. First, the SUBMISSION presupposes, without underlying support,

that the facts with respect to the "pairs" of design patents mentioned are the same as the facts in this case. Second, issuance of the "pairs" of design patents is not binding precedent at the Board of Patent Appeals and Interferences or the Federal Circuit. Third, to the extent issuance of the "pairs" of design patents is inconsistent with the decision we enter today, it should be noted that "two wrongs cannot make a right." In re Riddle, 438 F.2d 618, 620, 169 USPQ 45, 47 (CCPA 1971), quoting from Fessenden v. Coe, 99 F.2d 426, 432, 38 USPQ 516, 521 (D.C. Cir. 1938). Fourth, the "benefit" issue in this case arises because there is intervening prior art in the form of the American Inventors Corporation Brochure. There is no indication in the SUBMISSION, or the accompanying design patents, that there was any intervening prior art in the case of the "pairs" of design patents mentioned therein. Fifth, and perhaps most important, we call attention to a statement by Judge Rich for a unanimous en banc Federal Circuit to the effect that each case involving a benefit issue under 35 U.S.C. § 120 "will depend on its own fact situation." Racing Strollers, 878 F.2d at 1419, 11 USPQ2d at 1301 (first column).

E. Conclusions of law

1. The sole claim in the "continuing" design application is not entitled to the benefit of the filing date of the "parent" design application. 35 U.S.C. § 120.

2. The design of the sole claim in the "continuing" design application was not described in the "continuing" design application, as filed. 35 U.S.C. § 112, first paragraph.

3. The sole claim in the "continuing" design application is unpatentable under 35 U.S.C. § 103.

4. The sole claim in the "continuing" design application is unpatentable for failure to comply with the description requirement of 35 U.S.C. § 112, first paragraph.

5. Applicant's counsel failed to establish a good and sufficient reason for the belated SUBMISSION OF NEW EVIDENCE UNDER 37 CFR 1.194 and the patents attached thereto. 37 CFR § 1.195. Hence, the SUBMISSION should not be considered on its merits.

6. The decision of the Primary Examiner rejecting the sole claim in the "continuing" design application under 35 U.S.C. § 103 has not been shown to have been erroneous and therefore should be affirmed.

7. The decision of the Primary Examiner rejecting the sole claim in the "continuing" design application under 35 U.S.C. § 112, first paragraph, has not been shown to have been erroneous and therefore should be affirmed.

F. Discussion of Issue No. 3 and Issue No. 4

Issue No. 3 and Issue No. 4 have not been considered by the Primary Examiner. We believe the record on appeal dictates that

those two issues be considered at some point--should it become necessary. Ordinarily, we would (1) consider the issues ourselves in the first instance and enter a new ground of rejection under 37 CFR § 1.196(b) or (2) remand the appeal to the Primary Examiner for development of a record in the first instance.

In this case, however, we feel that the resolution of Issue No. 1 and Issue No. 2 is dispositive. Moreover, given that there are said to be 1,700 applications with similar issues, we feel entry of a final decision at this point is in the public interest, because it will permit applicant to seek judicial review of our affirmance of the § 103 and § 112 rejections. 35 U.S.C. §§ 141-145; 37 CFR § 1.196(b) and (e).

However, should there be further prosecution because applicant is successful on judicial review or should applicant elect to file another "continuing" application, then we feel that Issue No. 3 and Issue No. 4 should be thoroughly developed and considered on their merits. The following is provided as guidance to applicant and the Primary Examiner should consideration of Issue No. 3 and Issue No. 4 become necessary.

1. Issue No. 3

A complete examination needs to be made into the question of whether applicant is claiming what applicant regards as his invention. 35 U.S.C. § 112, second paragraph.

There are indications in the record that applicant may not regard a "design" as his invention.

a. In twice answering the REQUIREMENT FOR INFORMATION entered by the Primary Examiner, applicant provided inconsistent answers, inter alia, to the following question (0014-0015):

At the time you signed the declaration attesting to your inventorship, did you intend to apply for a design patent (covering the ornamental appearance) rather than a utility patent (covering the function)?

By a document dated November 20, 1993, applicant answered:

**No, I fully intended to apply for a Utility Patent covering the function** (0037).

Later, by a document dated April 5, 1994, applicant answered:

**Yes** (0062).

If the first answer is correct, then applicant may not be claiming what applicant regards as his invention. On the other hand, if the second answer is correct, then applicant may be claiming what applicant regards as his invention.

Applicant purports to explain why the answers are different stating that the first answer was given "without the benefit of advice of counsel and [that applicant] did not completely understand the questions at that time" (0096). Applicant's



explanation raises at least the following factual and credibility issues which need to be evaluated in detail:

(1) How much weight should be given to applicant's explanation for inconsistent answers? The second set of answers are said to be made following advice of counsel. We ask: "[C]ounsel" for whom--American Inventors Corporation, applicant, or both? It is readily apparent that counsel was retained by American Inventors Corporation and that the interests of American Inventors Corporation and applicant may not have been, and may not now, be the same.<sup>14</sup> American Inventors Corporation retains any fee paid by applicant if a patent issues. On the other hand, if a patent is denied, applicant would appear to be entitled to a refund. We note that by virtue of the injunction in Federal Trade Commission v. American Inventors Corp., supra, money may be available to repay the invention promotion fee which applicant paid to American Inventors Corp.

(2) If applicant did not understand the question in the REQUIREMENT FOR INFORMATION, the proper response would have been "I do not understand your question." "Do you mean 'x' or do you mean 'y'?" The notion that counsel should explain what the Primary Examiner meant gives us pause on this record under these

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<sup>14</sup> Our observations go only to the weight which should be given applicant's explanation of why he provided inconsistent answers to the REQUIREMENT FOR INFORMATION and resolving which answer, the first or second, should be given more weight. Ordinarily, the PTO accepts statements in declarations at face value. However, like other judicial and quasi-judicial tribunals, the PTO need not accept at face value a statement in a declaration when there is objective evidence in the record for questioning the statement.

circumstances, particularly when there is no statement on the record of how counsel might have explained what the Primary Examiner meant. Compare Hall v. Clifton Precision, a division of Litton Systems, Inc., 150 F.R.D. 525 (E.D. Pa. 1993) (witness should ask counsel asking the question, not his own counsel, what was meant by a question). In short, the Primary Examiner was not interested in counsel's answer to the questions. The Primary Examiner was interested only in applicant's answers. Any clarification should have been made by the Primary Examiner.

(3) Given events which transpired in connection with applicant's dealings with American Inventors Corporation, there probably are other documents which would shed light on what applicant regarded as his invention at the time the dealings started and at the time the "parent" design application, and possibly the "continuing" design application, were filed. Binding precedent permits consideration of documents outside the specification, drawings, and claims to determine whether an applicant regards the claimed subject matter as his/her invention. In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Some documents which may contain "material" information (within the meaning of 37 CFR § 1.56((b)(1) and/or (b)(2)) include:

(1) any initial description of the invention provided by applicant to American Inventors Corporation; and

(2) any American Inventors Corporation form completed by applicant at the request of American Inventors Corporation.

b. We have placed into the record a copy of Disclosure Document<sup>15</sup> 302,781 (0257-0262), filed in the PTO on March 9, 1992.

A review of the document reveals that it contains the following description of the invention, apparently in applicant's handwriting (0260):

"The Leecher" is a leech trap (leeches are \_\_\_\_ fishing bait in the upper Midwest). Usually they are trapped using a coffee can and putting holes in the sides with a drill or screwdriver then you attach a \_\_\_\_ rope, put liver or some kind of red meat inside the can and throw it out in a pond or lake. There are several problems occurred using a coffee can "all of which the Leecher solves!!" #1. Its made out of strong durable plastic, has weights on the bottom to pull it down in the water. It has a hook in the inside to place the bait which draws the leeches inside. It's got a screw top with a handle/rope or wire attached. The way it works is very easy, non-complicated, and simple to use. You just attach a rope or wire to the top, place your

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<sup>15</sup> See Manual of Patent Examining Procedure, § 1706 (6th ed., rev. 1, Sept. 1995); 37 CFR § 1.21(c).

meat on the inside hook, screw on top and throw the trap out into the pond (of course you have to attach the other end of the rope or wire to something stable on shore, such as a tree or dock). You leave it out overnight and come back in the morning of the next day and pull your trap in, open the top, and drop all the leeches into your bait pail. It can be used for personal fishing or for profit. Nothing is available on the market like it (at least not that I know of).

Various drawings of the "leecher" are set out in the Disclosure Document at (0261).

A drawing of a first embodiment looks similar to the embodiment set out in Figure 1 of the "continuing" design application, as amended (i.e., the leecher without surface ornamentation). A top view is described as having a "screw down top with handle/rope connector and as having a diameter of 8 inches and looks similar to the top view of Figure 5 of the "continuing" design application. A bottom view is described as including lead or steel weights. Unlike the bottom view of Figure 6 of the "continuing" design application, as amended (0163), the bottom view of the first embodiment depicted in the Disclosure Document shows "small holes." There are two openings in the weight section. While not described in the Disclosure Document, the openings in the weight section are to permit access to the holes in the bottom of the leecher. A side view is

described as having a "handle rope connector" at the top and "lead weight attached to bottom." A "side - cut in half" view is described as having (1) a screw drain top and (2) a steel hook for bait (usually liver), it being noted that "instead of a hook, a chain or rope within \_\_\_\_ attached to it would work equally well." Possibly in response to the statement at the top of (0261),

Please show any special features and any other alternatives you've considered in designing your invention,

two other "possible designs" are described. A first alternative "possible design" is a cylindrical embodiment (which looks rectangular when viewed from the side). A second alternative "possible design" has a rounded top portion (the embodiment could be described as having a cylindrical bottom half and a spherical top half).

There is no evidence apparent to us from the Disclosure Document which would indicate that applicant "created for the purpose of ornamenting." In re Carletti, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

The contents of the Disclosure Document are more consistent with applicant's first statement that he "fully intended to apply for a Utility Patent covering the function" (0037) than they are with applicant's second answer otherwise (0062). We have serious doubt that applicant is aware that the "other possible designs"

(0261) are not within the scope of the sole claim on appeal. In other words, we doubt applicant is aware that if the "continuing" design application issued as a design patent, applicant would not be able to exclude others from making, using or selling the "other possible designs" set out in the Disclosure Document. We may be wrong, but we doubt applicant understood the significant difference between the rights acquired through a utility patent vis-à-vis a design patent, particularly as applied to the facts of this case. Certainly, we find nothing in counsel's draft letter (0286, fourth full paragraph--Exhibit 3 of the Petition) which meaningfully would alert a layman to the significant consequences of seeking a design patent, as opposed to a utility patent, as applied to the facts of this case.

One issue facing the Primary Examiner in the event of further prosecution is assessing which one of the two inconsistent answers by applicant to the REQUIREMENT FOR INFORMATION is entitled to more weight. In short, the Primary Examiner would need to make a finding of fact as to what applicant regarded as his invention. The Disclosure Document and the first answer to the REQUIREMENT FOR INFORMATION are consistent with a finding that applicant regards a useful leecher as his invention. The second answer to the REQUIREMENT FOR INFORMATION is consistent with a finding that applicant regards a design of a leecher as his invention. There may be other evidence which may be helpful in evaluating the factual issue of

what the applicant regards as his invention. Because the record may not be complete, we do not at this time prejudge the question of whether applicant is claiming what he regards as his invention.

## 2. Issue No. 4

The purpose of the design patent law is to promote beauty, grace and ornamentation in articles of manufacture. In re Koehring, 37 F.2d 421, 422, 4 USPQ 169, 170 (CCPA 1930). A design patent may be granted only for a new, original and ornamental design; if the design is primarily functional rather than ornamental, a design patent may not properly issue because it is "non-ornamental." Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238, 231 USPQ 774, 777 (Fed. Cir. 1986); In re Carletti, 328 F.2d at 1022, 140 USPQ at 654. The design, as presently claimed, may be "non-ornamental" (often referred to as "functional") as opposed to "ornamental."

Examination of an issue of whether a design is non-ornamental, as opposed to ornamental, is not always easy. As Carletti makes clear, 328 F.2d at 1022, 140 USPQ at 654, the general rule can be stated as follows:

when a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple

reason that it is not "ornamental"--was not created for the purpose of ornamenting.

We will observe that there is nothing contained in the Disclosure Document or the American Inventors Corporation Brochure which would indicate that the design presently claimed in the "continuing design application" (i.e., a leecher without surface ornamentation) was created for the purpose of ornamentation. Rather, it would appear that it may have been created for utilitarian purposes.

Several points should be considered in examining the question of whether a configuration is primarily functional, as opposed to ornamental, remembering that each case must be decided on its own facts:

**Point (1):** An article of manufacture having a pleasing appearance is not per se ornamental; the configuration of the article may nevertheless be dictated solely by functional considerations.<sup>16</sup> Hence, an article of manufacture having a pleasing appearance may or may not be ornamental.

**Point (2):** An article of manufacture which may be constructed in the form of several configurations does not mean that any one of the several configurations is per se ornamental. All, some, or none of the configurations may be non-ornamental.

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<sup>16</sup> In re Carletti, 328 F.2d at 1022, 140 USPQ at 654 ("[m]any well-constructed articles of manufacture whose configurations are dictated solely by function are pleasing to look upon . . . .").



**Point (3):** If some or all the elements of an article of manufacture are individually dictated by functional considerations, the design of the article, as a whole, is not per se functional. The design of the article, as a whole, may or may not be ornamental.<sup>17</sup>

**Point (4):** The fact that a device<sup>18</sup> is "non-functional" for the purpose of evaluating whether the configuration of the article can function as a trademark within the meaning of the Lanham Act does not mean that the article is ornamental within the meaning of 35 U.S.C. § 171 of the Patent Law. An article which can serve as a trademark because it is "non-functional" may or may not be ornamental within the meaning of 35 U.S.C. § 171.

Various forms of evidence may be considered in examining whether a configuration of a design is dictated solely by functional considerations, including:

(a) "utility" patents describing the functional nature of elements of the article or of the article as a whole;

(b) sales or other promotional literature discussing the utilitarian or functional advantages of the article sought to be patented;

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<sup>17</sup> In re Garbo, 287 F.2d 192, 193, 129 USPQ 72, 73 (CCPA 1961) ("a design may embody functional features and still be patentable"); Avia Group International Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988) (there is a distinction between the functionality of an article or its features and the functionality of the particular design of the article or features).

<sup>18</sup> See 15 U.S.C. § 1127 (definition of the term "trademark").

(c) documents written by the inventor and/or others describing the features of the article;

(d) an opinion and/or statement by an individual qualified to study and who has studied the article;<sup>19</sup> and/or

(e) a statement by the inventor identifying the portions of the design which were created for the purpose of attempting to beautify an article.

We do not prejudge at this time whether the claimed leecher is non-ornamental. Rather, we leave a determination in the first instance of the leecher is ornamental or non-ornamental to the Primary Examiner should there be further prosecution with respect to applicant's invention.

G. Decision

The decision of the Primary Examiner rejecting the sole claim as unpatentable under 35 U.S.C. § 103 is affirmed.

The decision of the Primary Examiner rejecting the sole claim as unpatentable for failure to comply with the description requirement of 35 U.S.C. § 112, first paragraph, is affirmed.

H. Time for taking action

Any request for reconsideration must be filed within **one (1) month** of entry of this decision. 37 CFR § 1.197(b).

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<sup>19</sup> See the 5-point analysis relied upon by the Federal Circuit in Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d at 239, 231 USPQ at 778 (column 1).

The time for seeking judicial review is **two (2) months**.  
37 CFR § 1.304(a)(1).

The provision of the rules which permits the filing of a  
petition and a fee for an extension of time does not apply.  
37 CFR § 1.136(a)(1)(iv).

GARY V. HARKCOM, Vice Chief	)
Administrative Patent Judge	)
	)
	)
	)
IAN A CALVERT,	)
Administrative Patent Judge	)
	)
	)
	)
FRED E. McKELVEY, Senior	)
Administrative Patent Judge	)

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

## **Docket Entries of "Record on Appeal"**

### A. Papers in design application 07/902,055

1.		PTO Form-1556 .....	0001
2.	06-22-92	Specification (application 07/902,055) ..	0002
3.	06-22-92	Declaration and power of attorney .....	0003
4.	06-22-92	Small entity statement .....	0005
5.	10-07-93	Requirement for information .....	0008
		Affidavit of John Oller .....	0017
		Affidavit of Jo Ellen Oller .....	0020
		Affidavit of Bob Lougher .....	0023
6.	10-07-93	Letter of transmittal .....	0025
7.	10-07-93	Associate power of attorney .....	0026

### B. Papers in design application 29/020,787

1.		PTO Form-1556 .....	0027
2.	04-01-94	Petition and fee for extension of time .....	0028
3.	04-01-94	Request for filing a patent application under 37 CFR § 1.62 .....	0030
4.	04-01-94	Preliminary amendment .....	0033
5.	04-01-94	Statement of Scott J. Daniels dated 11/20/93 .....	0036
6.	04-01-94	Letter to official draftsman .....	0038
7.	05-04-94	Transmittal letter .....	0043
8.	05-04-94	Petition to make special .....	0044
9.	05-04-94	Preliminary amendment with	

		attached drawings .....	0047
10.	05-04-94	Copy of requirement for information with answers and declaration statement of Scott J. Daniels .....	0055
11.	05-20-94	Decision on petition to make special (granted) .....	0064
12.	06-28-94	Examiner's action .....	0065
13.	08-04-94	Transmittal letter .....	0071
14.	08-04-94	Response (by applicant) .....	0072
15.	08-04-94	Declaration of Scott J. Daniels dated 7/11/94 .....	0096
16.	08-04-94	Information disclosure statement .....	0097
		Form PTO-1449 .....	0098
		U.S. Patent N° 4,914,856 .....	0099
		U.S. Patent N° 4,821,452 .....	0104
		U.S. Patent N° 3,748,776 .....	0107
		U.S. Patent N° 4,831,774 .....	0114
		U.S. Patent N° 4,625,452 .....	0117.1
		Brochure distributed by American Inventors Corporation approximately during August 1992 .....	0120
17.		Information disclosure statement review form Group 220/290 .....	0121
18.	09-13-94	Examiner's action .....	0122
19.	09-13-94	Form PTO-892 .....	0128
		U.S. Design Patent N° 128,787 .....	0129
20.	11-14-94	Transmittal letter .....	0131
21.	11-14-94	Notice of appeal .....	0132

22.	11-14-94	Brief on appeal .....	0133
		Appendix "A" (drawings in applications 07/902,055 and 29/020,787 as filed) .....	0161
		Appendix "B" (drawings as amended in application 29/020,787) .....	0165
23.	01-11-95	Power to inspect, make copies and conduct interviews .....	0170
24.	01-11-95	Examiner's answer .....	0173
25.	01-17-95	Communication (reply brief waived) .....	0188
26.	03-31-95	Submission of new evidence .....	0189
		U.S. Design Patent N° 291,144 .....	0203
		U.S. Design Patent N° 299,583 .....	0206
		U.S. Design Patent N° 303,315 .....	0208
		U.S. Design Patent N° 297,281 .....	0210
		U.S. Design Patent N° 298,982 .....	0213
		U.S. Design Patent N° 249,303 .....	0216
		U.S. Design Patent N° 260,330 .....	0219
		U.S. Design Patent N° 246,857 .....	0222
		U.S. Design Patent N° 256,726 .....	0226
		U.S. Design Patent N° 248,564 .....	0230
		U.S. Design Patent N° 255,921 .....	0236
		U.S. Design Patent N° 321,659 .....	0239
		U.S. Design Patent N° 336,048 .....	0242
		U.S. Design Patent N° 340,594 .....	0244
		U.S. Design Patent N° 347,533 .....	0246

		U.S. Design Patent N° 336,087 .....	0248
		U.S. Design Patent N° 353,820 .....	0253
		<u>Material added to the record</u> <u>for consideration in the event of</u> <u>further prosecution following an appeal</u> <u>or the filing of a further continuation</u>	
27.	03-09-92	Disclosure document .....	0257
28.	02-10-94	Notice of suspension, 1160 Off. Gaz. Pat. Office 39 (Mar. 8, 1994) .....	0264
29.	04-18-94	Petition for personal intervention by the Commissioner of Patents the Honorable Bruce A. Lehman (parts) .....	0265
30.	09-02-94	Caveat Inventor: Invention Marketing Scams: Hearing Before the Senate Subcommittee on Regulation and Government Information of the Committee on Governmental Affairs, 103d Cong., 2d Sess. (1994) .....	0299
31.	10-26-95	FTC News .....	0325
32.	11-16-95	Federal Trade Commission v. American Inventors Corp., 37 USPQ2d 1154 (D. Mass. 1995) .....	0328

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Attachment:

Record on Appeal, including material relevant to Issues 3  
and 4, with renumbered pages